

Remarks

In view of the following amendments and remarks, favorable reconsideration of the outstanding office action is respectfully requested. Claims 1 – 21 remain in this application.

1. Allowed Claims/Subject Matter

Applicant notes with appreciation the Examiner's allowance of claim 20 and claim 21, and further, that the Examiner has indicated the subject matter of claims 2, 15 – 17 and 19 are patentable and would be allowable if rewritten in independent form.

2. § 103 Rejections

A. Claims 1, 6, 7, 9, 10, 12 – 14, and 18

The Examiner has rejected claims 1, 6, 7, 9, 10, 12 – 14, and 18 under 35 U.S.C. § 103 as being unpatentable for obviousness over U.S. Patent No. 6,883,927 to Cunningham et al. (hereinafter Cunningham).

The applicant respectfully traverses the rejection because the Examiner does not make a *prima facie* case for obviousness. The Examiner does not make a *prima facie* case for obviousness because she does not show where the reference teaches or suggests all of the claim limitations and also because she does not provide any proper suggestion or motivation for modifying the cited reference.

According to the **MPEP 2143**, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The prior art reference does not teach or suggest all the claim limitations.

Before discussing each element of the claim relative to Cunningham, the applicant respectfully asks the Examiner to compare the Figures in Cunningham with both the Figures

provided in the present invention and independent claims 1, 12, and 18. The applicant suggests that the comparison is a stark one. In particular, when one compares Figure 3a of Cunningham with both Figure 1 and independent claims 1, 12, and 18 of the present invention it becomes abundantly clear that the present invention is directed to an electrical wiring device and lamp receptacle formed within *a single device housing*, whereas Cunningham teaches a wall plate assembly having an illuminated frame and cover. The electrical outlet wiring device 52 has none of the features recited in the independent claims. The lighting elements shown by Cunningham are not part of the electrical device, but rather external to it, being disposed in frame 42. The element-by-element analysis mandated by *In re Vaeck* is provided below.

Claim 1:

Claim 1 is directed to an electrical wiring device. Cunningham, on the other hand, is directed to a *frame assembly* that employs a wiring device 52. The first element of claim 1 is a *device housing*. The Examiner asserts that Cunningham's reference element 2 is a device housing. The applicant respectfully directs the Examiner's attention to col. 2, line 66 – col. 3, line 26. The cited text identifies reference element 2 as being a *frame assembly*. The frame assembly 2 is shown to include a frame member 42 and cover plate 40. Col. 3, lines 16 – 19 identify element 40 as a standard wall cover plate for electrical outlets. The text also says that "Frame 42 is rectangular and is shaped to fit over standard wall conduits for an electrical outlet." In other words, the electrical outlet 52, i.e., the wiring device, fits into the standard wall conduit (i.e., the wall box) and frame 42 fits over both. The applicant suspects that the Examiner is interpreting the claim language in a rather expansive way. The applicant respectfully reminds the Examiner that it is the applicant's right to define the meaning of claim language, i.e., to be his own lexicographer. The Examiner is not entitled to redefine claim language to fit the rejection. Those of ordinary skill in the art understand what is meant by the terms *electrical wiring device* and *device housing* – and frame assembly 2 does not fit that definition. As such, the Examiner has misidentified frame assembly 2 as a device housing. The applicant respectfully suggests that the wiring device shown in Cunningham is receptacle outlet device 52. Thus, the housing of outlet 52 is, in fact, the device housing.

Claim 1 recites *at least switch disposed within the device housing, the at least one switch including at least one terminal member configured to be coupled to the electric circuit*. The Examiner's rejection states that "Cunningham shows...at least one switch 58,

which is coupled to an electrical circuit.” Applicant respectfully points out that electrical wiring device 52 includes receptacle *connections* 58 disposed in device 52. See col. 3, lines 21 – 25. Clearly, Cunningham does not teach or suggest a switch element disposed in device 52.

Claim 1 further recites *a lamp receptacle formed in the device housing*. The claim element goes on to recite that the lamp receptacle includes a contact member that is electrically coupled to the at least one terminal member. The Examiner asserts that Cunningham discloses a lamp receptacle 64 formed in the housing with a lamp module 60 which consists of LEDs mounted on a circuit board 62. Applicant respectfully points out that reference element 64 is not disposed in the housing of the electrical device 52. Referring to Figure 3a and col. 3, lines 38 – 42, Cunningham states that:

“Lights 6 are part of light circuit 60...Light circuit 60 is etched in printed circuit board 62 (PCB 62). PCB 62 is mounted in frame 42 below slots 64 and is oriented to have lights 6 facing downward towards apertures 8.

Accordingly, reference element 64 is not a lamp receptacle formed in the device housing. Figure 3a clearly shows that it is a slot, or a notch, formed in frame 42. Figure 3a also very clearly shows that wiring device 52 does not include any lamp receptacle formed therein. Accordingly, the Examiner does not show where Cunningham teaches or suggests the recited *lamp receptacle formed in the device housing*.

Claim 1 further recites *a lamp module including at least one contact member and a light emitting element, the lamp module configured to be inserted into the lamp receptacle such that the circuit contact member engages the contact element...*” The applicant’s review of the rejection shows that the Examiner appears to ignore the above stated claim language. The applicant respectfully points out that the Examiner must consider all of the recited claim language. Cunningham simply does not teach or suggest a lamp module that is configured to be inserted and removed from the wiring device. Cunningham, on the other hand, shows piece parts 62, 68, 66, and 74 that are chained together and stuffed into the void formed by frame 42 and cover plate 40. Thus, the Examiner does not show where Cunningham teaches or suggests the recited *lamp module*.

Claim 12:

Claim 12 is directed to a method for installing the electrical device recited in claim 1. The analysis of claim 1 provided above fully applies to claim 12. Claim 12 recites the step of

“providing an electrical wiring device including a device housing...at least one switch disposed with the device housing...a lamp receptacle formed in the device housing.” As noted above, Cunningham does not teach or suggest a wiring device having *at least one switch* or a *lamp receptacle* formed therein. The Examiner does not show that outlet wiring device 52 includes any of the limitations recited above.

Claim 12 recites the steps of *providing a lamp module* configured to be inserted into the lamp receptacle and *inserting the lamp module* into the receptacle. The Examiner failed to discuss these method steps in her rejection and, indeed, does not show how or where Cunningham teaches or suggests these method steps.

Claim 18:

Claim 18 is directed to a method for making the electrical device recited in claim 1. The analysis of claim 1 fully applies to claim 18. Claim 18 recites the step of *“providing a device housing...having a lamp receptacle formed therein...”* The Examiner does not, nor indeed can she, point to any place in Cunningham that teaches or suggests a wiring device having a *lamp receptacle* formed therein. Outlet wiring device 52 simply does not include the limitations recited in this element.

Claim 18 recites the step of *disposing at least one wiring device within the housing, the at least one wiring device including a switch*. As shown above, Cunningham’s outlet device 52 does not include a switch device.

Claim 18 also recites the step of *providing a lamp module* configured to be inserted into the lamp receptacle and *inserting the lamp module* into the receptacle. Again, the Examiner failed to discuss these method steps in her rejection and, indeed, does not show how or where Cunningham teaches or suggests these method steps.

There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference teachings.

The Examiner provides no suggestion either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Cunningham. Without some suggestion or motivation, it is axiomatic that there can be no prima facie case of obviousness.

In light of the foregoing, the Examiner has failed to make a prima facie case of obviousness because she does not show where the cited reference teaches or suggests all of the claim limitations and also because she does not provide any proper suggestion or motivation for modifying the cited reference. Accordingly, the applicant respectfully asserts that claims 1, 6, 7, 9, 10, 12 – 14, and 18 are patentable under 35 U.S.C. § 103.

B. Claims 3 – 5, 8 and 11

The Examiner has rejected claims 3 – 5, 8, and 11 under 35 U.S.C. § 103 as being unpatentable for obviousness over Cunningham in view of U.S. Patent No. 6,010,228 to Blackman et al. (Blackman).

The applicant respectfully traverses the rejection because the Examiner does not make a prima facie case for obviousness. The Examiner does not make a prima facie case for obviousness because she does not show where the references teach or suggest all of the claim limitations and also because she does not provide any proper suggestion or motivation for combining the cited references.

The prior art references do not teach or suggest all the claim limitations.

Claims 3 – 5, 8:

Claims 3 – 5 are directed to the form factor of the lamp module. The Examiner asserts that Blackman teaches the use of a lens 22 to cover LEDs. While Blackman does indeed show a lens 22, Blackman does not show a lamp module that is configured to be inserted into, and/or removed from, a lamp receptacle disposed in an electrical wiring device. Further, the Examiner does not assert that Blackman remedies the deficiencies of Cunningham described above. Accordingly, while claims 3 – 5 and 8 are allowable in their own right, they are also allowable by virtue of their dependency from claim 1.

Claim 11:

Claim 11 is directed to a lamp module for use in an electrical device. Neither Cunningham nor Blackman teach or suggest, whether taken alone or in combination, a lamp module configured to be inserted into an electrical wiring device. As analyzed in detail above, the outlet 52 of Cunningham does not accept or include an insertable lamp module.

The switch device 122 of Blackman also does not accept or include an insertable lamp module. Blackman shows a lens cap 22 that may be fitted into a wall plate housing 20. The wall plate housing is shown to fit over a standard single switch wiring device 122. See col. 3, lines 47 – 67.

Claim 11 recites a *housing configured to be inserted into the electrical device*. The Examiner has failed to show where either Cunningham or Blackman teach or suggest, whether taken alone or in combination, a housing configured to be inserted into an electrical device.

With regard to the recited PCB, Cunningham shows a PCB that may be clipped into a notch 64 disposed in frame 42. The Examiner does not point to any PCB disclosed by Blackman. Accordingly, the Examiner has failed to show where either Cunningham or Blackman teach or suggest, whether taken alone or in combination, a PCB disposed in a housing that is insertable into an electrical wiring device.

There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference teachings.

The Examiner states that it would be obvious to one of ordinary skill in the art to cover the LEDs in Cunningham with the lens disclosed by Blackman because both are directed to wall mounted switch devices and lenses protect LEDs from damage. The Examiner's statement has at least two problems associated with it. First, even if the references were combinable, which they are not, the combination yields a wall plate assembly that includes lights; it does not yield a lamp module insertable into an electrical wiring device. In other words, the combination is irrelevant with regard to the claimed invention. Second, the Examiner's statement is not quite accurate because the invention is not directed to *wall mounted switch devices*, but rather to wall plate assemblies that accommodate such devices. Thus, the combination of Cunningham and Blackman does not yield the claimed invention.

As such, the Examiner has failed to make a prima facie case of obviousness because she does not show where the cited references teach or suggest all of the claim limitations and

also because she does not provide any proper suggestion or motivation for combining the cited references. Accordingly, claims 3 – 5, 8, and 11 are patentable under 35 U.S.C. § 103.

3. Conclusion

Based upon the remarks and papers of record, Applicant believes the pending claims of the above-captioned application are in allowable form and patentable over the prior art of record. Applicant respectfully requests reconsideration of the pending claims 1 – 21 and a prompt Notice of Allowance thereon.

Applicant believes that no extension of time is necessary to make this Response timely. Should Applicant be in error, Applicant respectfully requests that the Office grant such time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Response timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 50-1546.

Please direct any questions or comments to Daniel P. Malley at (607) 330-4010.

Respectfully submitted,

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